

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: ZALEVSKY4

In re Application of:)	
)	
Zeev ZALEVSKY et al)	Confirmation No. 2605
)	
Appln. No.: 10/565,623)	Washington, D.C.
)	
Filed: March 9, 2001)	December 4, 2006
)	
For: METHOD FOR PRODUCTION OF)	
MICRO-OPTICS STRUCTURES)	

PETITION UNDER 37 C.F.R. §1.183

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Petitions
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Pursuant to 37 C.F.R. §1.183, applicants hereby
petition for waiver of the requirement of 37 C.F.R.
§1.497(d)(1) that requires a statement from each person being
added as an inventor that any error in inventorship in the
international application occurred without deceptive intention
on his part.

STATEMENT OF FACTS INVOLVED

The present application is the national stage of
international application no. PCT/IL2004/000678, filed July
25, 2004. This international application claims benefit of
U.S. provisional application no. 60/490,655, filed July 24,
2003.

The inventors listed with respect to U.S. provisional application no. 60/490,655 include Yuval Kapellner, along with Zeev Zalevsky, Vardit Eckhouse and Izhar Humi (who subsequently changed his name to Izhar Eyal).

At the time that the PCT application was filed, two additional inventors were added because additional subject matter was added to the specification. The two additional inventors were Arkady Rudnitsky and Nadav Cohen. See declaration of Devin Katz submitted herewith.

At the time that the Request form was prepared for filing with the new PCT application on July 25, 2004, an inadvertent error was made. While Yuval Kapellner was clearly intended to have been included as an inventor, his name was inadvertently listed on the line for applicant for other than the U.S., rather than on the "inventor/applicant for U.S. only" line. See Devin Katz declaration.

When Yuval Kapellner noticed that he was not listed as an inventor on this application, he sent an email to Devin Katz, in the office of the Israeli patent attorneys handling the case, asking him to correct this error. See Devin Katz declaration and accompanying exhibits.

By this time the international application had already entered the national and regional stages and it was too late to make the correction before the PCT office.

When asked to execute the appropriate declaration form for entering the U.S. national stage, inventor Yuval Kapellner refused to sign it. See the Petition under 37 CFR §1.47(a) filed on even date herewith and accompanying documentation.

The declarations under 35 USC 371(c)(4) filed on even date herewith name all six intended inventors, including Yuval Kapellner. A petition under 37 CFR §1.47(a) is also filed on even date herewith in view of three non-signing inventors (including Yuval Kapellner).

ACTION REQUESTED

Applicants request that the requirement of 37 C.F.R. §1.497(d)(1) that requires a statement from each person being added as an inventor that any error in inventorship in the international application occurred without deceptive intention on his part, be waived in this case so that the request for correction of inventorship, filed herewith, will be considered to be acceptable.

ARGUMENT

The regulation applicable to the situation in which the declaration filed in the national stage names an inventive entity different from the inventive entity set forth in the international application is 37 CFR §1.497(d). In this situation, 37 CFR 1.497(d)(1) requires the submission of:

(1) A statement from each person being added as an inventor ... that any error in inventorship in the international application occurred without deceptive intention on his or her part.

MPEP 201.03 deals with an analogous regulation for correcting the inventive entity in a non-provisional application in which a declaration has already been filed naming the incorrect inventive entity (37 CFR §1.48(a)). There, 37 CFR 1.48(a)(2) requires "a statement from each person being added as an inventor ... that the error in inventorship occurred without deceptive intention on his or her part." With respect to this requirement, MPEP 201.03II.A. states:

On very infrequent occasions, the requirements of 37 CFR 1.48(a) have been waived upon the filing of a request and fee under 37 CFR 1.183 (along with the request and fee under 37 CFR 1.48(a)) to permit the filing of a statement by less than all the parties required to submit a statement. *In re Cooper*, 230 USPQ 638, 639 (Dep. Assist. Comm'r Pat. 1986). However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. *In re Hardee*, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). As 37 CFR 1.48(a) is intended as a simple procedural remedy and does not represent a substantive determination as to inventorship, issues relating to the inventors' or alleged inventors' actual contributions to conception and reduction to practice are not appropriate for consideration in determining whether the record unequivocally supports the correction sought.

In those situations where an inventor to be added refuses to submit a statement supporting the addition or such party cannot be reached, waiver under 37 CFR 1.183 of the requirement for a statement from that party would be appropriate upon a showing of such refusal or inability to reach the inventor. Every existing assignee of the original named inventors must give its consent to the requested correction.

Here, the facts unequivocally support the correction sought. The declaration of Devin Katz establishes that the error was simply a clerical error. He was instructed to include Yuval Kapellner as an inventor and Yuval Kapellner was included as an inventor in the priority application. Furthermore, Yuval Kapellner himself requested that the error be corrected. Since then, however, he has refused to cooperate in signing the declaration form until an alleged payment issue is resolved. Accordingly, it is not possible to obtain the required statement from Mr. Kappelner at the present time.

For these reasons, this represents an extraordinary situation in which justice requires waiver of this requirement. There are indeed two reasons why this waiver is in order. First, the facts unequivocally support the correction sought in the inventive entity and so no statement signed by Yuval Kapellner should be necessary. Second, and independently, Yuval Kapellner has refused to sign the declaration in this case, necessitating the filing under 37

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CFR §1.47. Thus, it is not believed that he will sign such a form even if asked.

An authorization to charge the petition fee of \$400 under 37 CFR §1.17(f), as required by 37 CFR §1.183, is submitted herewith.

CONCLUSION

Accordingly, granting of this petition, waiver of 37 §1.497(d)(1), and acceptance of applicants' request for correction of inventorship, filed herewith, are earnestly solicited.

Respectfully submitted,

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